IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Docket No.: 00240337US

Cary Lee BATES, *et. al.*

Serial No.: 09/827,233   Group Art Unit: 2143

Filed: April 5, 2001   Examiner: MAURO JR., Thomas J.

For: **METHOD AND COMPUTER PROGRAM
       PRODUCT FOR PROVIDING EMAIL
       THAT GUIDES A RECIPIENT THROUGH
       A SET OF ASSOCIATED WEB PAGES**

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. 1.131

Sir:

    We, **Cary Lee Bates, Paul R. Day, John M. Santosuosso, and Waheed Sujjad**, do hereby declare:

    1.   We are co-inventors of the subject matter disclosed and recited in independent claims 1, 2, 3, 8, 9, 10, and 11 of the above-identified application.

    2.   We completed the invention of claims 1, 2, 3, 8, 9, 10, and 11 (and those claims dependent thereon) in the United States **before January 23, 2001**, as evidenced below.

CONCEPTION

    3. Before **January 23, 2001**, we conceived of a method and computer program product for providing email that guides a recipient through a set of associated web pages as disclosed and

recited in independent claims **1, 2, 3, 8, 9, 10, and 11** of the application, of which is evidenced by the invention disclosure attached hereto as Exhibit A. The invention disclosure attached hereto is a photocopy of and is identical to the original, except that all pertinent dates have been removed therefrom.

4. All pertinent dates removed from the invention disclosure documentation attached hereto are **before January 23, 2001.**

5. As evidenced by the attachment the method and computer program product for providing email that guides a recipient through a set of associated web pages include at least:

      a.   composing an email to be sent from an originator to a recipient;

      b.   in response to the input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient; and

      c.   associating the navigation with the email;

      d.   sending the email and navigation to the recipient;

6. In further embodiments, as evidenced by the attachment, method and computer program product also include, for example:

      e.   passing the navigation to a web browser;

      f.   displaying by the browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed, wherein the preferred viewing order is included in the navigation.

7. The benefits and features of the method and computer program product for providing email that guides a recipient through a set of associated web pages are shown and described in the attachment.

8. These features and others are exemplified in the figures in at least the invention disclosure, which is a complete and permanent idea of the complete and operable invention

DUE DILIGENCE

9. Prior to **January 23, 2001**, we worked diligently on the invention, as recited in the invention disclosure, and the subsequent above-identified application until such application was completed and filed on **April 5, 2001.**

10. Specifically, we worked diligently in providing information to IBM in-house counsel in order to begin the preparation of a patent application for filing in the U.S. Patent Office. All of the inventors were involved in working diligently in providing IBM in house counsel the pertinent information relating to the inventive concept, including completing the attached Inventor Disclosure. For example, the pertinent information was communicated to IBM in-house counsel on or before **July 7, 2000.**

11. Prior to the filing of the above-identified application in the U.S. Patent Office, **Inventor Cary Bates and/or Inventor Waheed Sujjad** communicated with IBM patent counsel, on behalf of all of the inventors, in preparing such patent application based on the submitted Invention Disclosure. At least one such communication occurred on **November 11, 2000.** Another communication occurred on **February 27, 2001.** Thereafter, the inventors worked diligently on the preparation of the patent application with IBM patent counsel **David Irvin** until a final draft patent application was completed to our satisfaction. All of the inventors were involved in reviewing and finalizing the application for the present invention prior to the filing of the above-identified application.

12. A final draft of the application was forwarded to us by IBM in-house attorney, **David Irwin,** on or about **March 13, 2001.** At all times, we worked diligently to finalize the

application for filing in the U.S. Patent and Trademark Office from prior to **January 23, 2001** to the finalized application on **April 5, 2001,** as evidenced herein.

13. The patent application was filed in the U.S. Patent and Trademark Office on **April 5, 2001**.
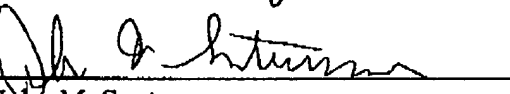
14. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon

Cary Lee Bates   Date   11-9-04

Paul R. Day   Date   11-9-2004

John M. Santosuosso   Date   11-9-2004

Waheed Sujjad   Date

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14. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon

_____
Cary Lee Bates

_____
Date

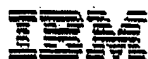_____
Paul R. Day

_____
Date

_____
John M. Santosuosso

_____
Date

_____
Waheed Sujjad

_____
11-10-2004
Date

\\COM\452342.1

Facsimile Transmittal

IBM

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Date:

Total Pages: 6 (Including this one)

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_____PRIVILEGED REVIEW REQUIRED
_____PLEASE CONFIRM RECEIPT

To: Andrew Calderon

From: Colleen Bulman

Direct Phone: T/L 620-5739

Outside line: (607)429-5739

Fax Number: 703-712-5050

Re: IBM Doccket Number RSW9   J47

Per John Pivnichny's request, I am faxing you RAL8-   -0118.

Disclosure RAL8- -0118

Created By: Waheed Sujjad **Created On:**
Last Modified By: Saundra Christopher **Last Modified On:**

Required fields are marked with the asterisk (*) and must be filled in to complete the form .

Summary

Status	Under Evaluation
Original Location	FIS
Processing Location	RAL
Functional Area	GLOBAL SERVICES
Attorney/Patent Professional	Dan Mcconnell/Raleigh/IBM
IDT Team	Dan McConnell/Raleigh/IBM; EDWARD KELLEY/Fishkill/IBM; Judy Stackhouse/Greensboro/IBM; Glynn Furr Jr/Raleigh/IBM; Dawn Garner/Raleigh/IBM; Joel Gempler/Raleigh/IBM; Mike Marsh/Raleigh/IBM; Donald Moore/Raleigh/IBM; Matthew Wang/Raleigh/IBM; Salim Halim/Raleigh/IBM; Jerry Haegele/Raleigh/IBM; Tracy Norris/Raleigh/IBM; David Snow/Raleigh/IBM; Robert W Freitag/Southbury/IBM; Murthy Rallapalli/Bismarck/IBM
Submitted Date	03:35:45 PM
Owning Division	GS
PVT Score	To calculate a PVT score, use the 'Calculate PVT' button.
Incentive Program	
Lab	
Technology Code	

Inventors with Lotus Notes IDs

Inventors: Waheed Sujjad/Lexington/IBM, Cary Bates/Rochester/IBM, Paul Day/Rochester/IBM, John Santosuosso/Rochester/IBM

Inventor Name > denotes primary contact	Inventor Serial	Div/Dept	Manager Serial	Manager Name
> Sujjad, Waheed	2A7998	07/D7CD	520304	Wheeler, Kendall
Bates, Cary L	490454	7T/LAHA	300553	Adolphson, John M.
Day, Paul R	709414	7T/HRGA	448534	Aird, Daniel J. (Dan)
Santosuosso, John M	427031	7S/XLUA	436010	Majd, Mahdad

Inventors without Lotus Notes IDs

IDT Selection

IDT Team:	Attorney/Patent Professional:
Dan McConnell/Raleigh/IBM EDWARD KELLEY/Fishkill/IBM Judy Stackhouse/Greensboro/IBM Glynn Furr Jr/Raleigh/IBM Dawn Garner/Raleigh/IBM Joel Gempler/Raleigh/IBM Mike Marsh/Raleigh/IBM Donald Moore/Raleigh/IBM Matthew Wang/Raleigh/IBM	Dan Mcconnell/Raleigh/IBM

Salim Halim/Raleigh/IBM
Jerry Haegele/Raleigh/IBM
Tracy Norris/Raleigh/IBM
David Snow/Raleigh/IBM
Robert W Freitag/Southbury/IBM
Murthy Rallapalli/Bismarck/IBM

Response Due to IP&L :

Main Idea

*Title of disclosure (in English)
E-mail with navigational assist

*Idea of disclosure

1. Describe your invention, stating the problem solved (if appropriate), and indicating the advantages of using the invention.

Today many users send e-mail with links to web pages. Often the sender expects the receiver to visit the referenced URLs and navigate along a particular path based on the explanation the sender provides in the message text. The problem that occurs is that the user has to continually refer back to the original message to know where to go next, resulting in a cumbersome and error prone process. A need exists for navigational assistance to be included with the e-mail message.

2. How does the invention solve the problem or achieve an advantage,(a description of "the invention", including figures inline as appropriate)?

This invention allows the sender to include a list of urls which are associated with individual links that reside in the message text of an e-mail such that when the link in the message text is clicked, the browser will be provided the list of urls associated with the link, and if the page to be displayed contains a link to one of these urls, this link will be highlighted to set it apart from the other links.

Our invention works as follows:

1. Before sending the e-mail, the user activates a start list operation, then clicks on a link within the message text for which the sender wants to provide navigational assistance.
2. The sender clicks the hypertext link(s) in the current page that they want the receiver to visit, and continues following these links until all the links they want to point out have been visited.
3. Now the sender simply closes the copy of the browser that was launched in step 1 (or indicates "done" or "send") and the list of urls visited during that browser session is stored with the e-mail message and associated with the links clicked in step 1.
4. The e-mail message is now sent with this navigational information included.
5. The reciver receives the e-mail, and clicks the hypertext in the message text.
6. The resulting instance of the browser is given this navigational information that came with the e-mail, and highlights the links visited in step 2.
7. The receiver can then easily navigate to all the sites the sender intended without the need to refer back to the text in the email message.
8. If the sender wants to send more than one link from a single page, s/he can press a certain key to color code the priority of the links(eg; "b" for blue or 1st priority, and "y" for yellow or 2nd priority, or some other designation such as by icon). If priority is not selected, all the links would be of the same priority and up to the receiver to visit the links in the order they want.
9. If for example the blue color is the first priority, and yellow is the second, the sender can move the mouse over the link and press "b" and that link will be added to the list in blue color (first priority),

same as with the yellow (low priority).
10. If links are priortized by color coding, the sender can instruct the receiver to visit all the links highlighted in blue before visiting the links highlighted in yellow, and so forth.

3. If the same advantage or problem has been identified by others (inside/outside IBM), how have those others solved it and does your solution differ and why is it better?

4. If the invention is implemented in a product or prototype, include technical details, purpose, disclosure details to others and the date of that implementation.

*Critical Questions (Questions 1 - 7 must be answered)

Question 1
On what date was the invention workable?   **Please format the date as MM/DD/YYYY**
(Workable means i.e. when you know that your design will solve the problem)

Question 2

Is there any planned or actual publication or disclosure of your invention to anyone outside IBM?	○ Yes ● No
If yes, Enter the name of each publication or patent and the date published below. Publication/Patent: Date Published or Issued:	
Are you aware of any publications, products or patents that relate to this invention?	○ Yes ● No
If yes, Enter the name of each publication or patent and the date published below. Publication/Patent: Date Published or Issued:	

Question 3

Has the subject matter of the invention or a product incorporating the invention been sold, used internally in manufacturing, announced for sale, or included in a proposal?	○ Yes ● No
Is a sale, use in manufacturing, product announcement, or proposal planned?	○ Yes ● No
If Yes, identify the product if known and indicate the date or planned date of sale, announcements, or proposal and to whom the sale, announcement or proposal has been or will be made. Product: Version/Release: Code Name: Date: To Whom: If more than one, use cut and paste and append as necessary in the field provided.	

Question 4

Was the subject matter of your invention or a product incorporating your invention used in public, e.g., outside IBM or in the presence of non-IBMers?	○ Yes ● No
If yes, give a date. **Please format the date as MM/DD/YYYY**	

Question 5

Have you ever discussed your invention with others not employed at IBM?	○ Yes ● No
If yes, identify individuals and date discussed. Fill in the text area with the following information, the names	

Page 3

of the individuals, the employer, date discussed, under CDA, and CDA #.

Question 6	
Was the invention, in any way, started or developed under a government contract or project?	◯ Yes ● No ◯ Not sure
If Yes, enter the contract number	

Question 7	
Was the invention made in the course of any alliance, joint development or other contract activities?	◯ Yes ● No ◯ Not Sure
If Yes, enter the following :Name of Alliance, Contractor or Joint Developer	
Contract ID number	
Relationship contact name	
Relationship contact E-mail	
Relationship contact phone	

Question 8	
Have you submitted, or are you aware of, any related disclosure submission?	◯ Yes ● No
If Yes, please provide the title and docket or disclosure number below:	

Question 9

What type of companies do you expect to compete with inventions of this type? *Check all that apply.*

- ☐ Manufacturers of enterprise servers
- ☐ Manufacturers of entry servers
- ☐ Manufacturers of workstations
- ☐ Manufacturers of PC's
- ☐ Non-computer manufacturers
- ☐ Developers of operating systems
- ☐ Developers of networking software
- ☒ Developers of application software
- ☒ Integrated solution providers
- ☒ Service providers
- ☐ Other (Please specify below)

Patent Value Tool (Optional - this may be used by the inventor and attorney to assist with the eval

(The Patent Value tool can be used by you or the evaluation team to determine the potential licensing value of your invention.)

The **Patent Value Tool** has not yet been used to calculate a score.

Post Disclosure Text & Drawings

RAL8)118 E-mail with nav.....al assist - continued

Enter any additional information relating to this disclosure below:

_____
(Form Revised 12/17/97)

RAL8)118 E-mail with nav.....al assist - continued